



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/506,808 | 02/18/2000 | Masakatsu Mori | ASA-672 | 8316 |

7590 04/08/2005

MATTINGLY, STANGER & MALUR, P.C.
104 East Hume Avenue
Alexandria, VA 22301

| |
|----------|
| EXAMINER |
|----------|

GART, MATTHEW S

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

3625

DATE MAILED: 04/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/506,808

Applicant(s)

MORI ET AL.

Examiner

Matthew s Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/31/02</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 3625

DETAILED ACTION

Claims 1-33 have been canceled.

Claims 34-49 are pending in the instant application.

Specification - Title

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Terminal Disclaimer

The terminal disclaimer filed on 8/21/2002 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent 6,044,363 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Drawings

This application has been filed with informal drawings, which are acceptable for examination purposes only. All of the figures contain improper handwritten lines and text, which may affect clarity when reproduced.

Applicant is required to submit a formal correction of the noted defect. Applicant is required to submit drawing corrections promptly. Drawing objections may no longer be held in abeyance.

Art Unit: 3625

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 37, 39 and 45-49 are rejected under 35 U.S.C. 112, first paragraph.

Claims 37, 39 and 45-49 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite an auction device which contains numerous modules, i.e. a first module, a second module, a third module, etc. The specification does not explicitly disclose functionally or structurally a module. The examiner is interpreting a module as a set of computer instructions embedded in a computer readable medium causing a computer to perform certain activities.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 37-39 and 45-49 are rejected under 35 U.S.C. 112, second paragraph.

Claims 37, 39 and 45-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Newly added claim limitations must be

Art Unit: 3625

supported in the specification through express, implicit, or inherent disclosure. The specification as originally filed does not expressly, implicitly, or inherently describe an auction device, which contains numerous modules.

Claims 38-39 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 38-39 discloses an auction device in accordance with claim 36. Claim 36 discloses an auction method. It is improper to have a device claim dependent upon a method claim.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 34-49 rejected under 35 U.S.C. 102(e) as being anticipated by Fisher

U.S. Patent No. 5,835,896.

Referring to claim 34. Fisher discloses an auction method of determining a successful bidder, the auction method being executed in a server computer (Fisher: Fig. 1, “**250**”) connected with a plurality of client computers (Fisher: Fig. 1, “**210**”) via a network (Fisher: Fig. 1, “**275**”), each client computer belonging to a respective bidder, the auction method comprising the steps of:

- a) Transmitting, from the server computer, information on a product to be auctioned to the plurality of client computers via the network (Fisher: Fig. 2, “Cordless 10-Channel Phone Model 5400”);
- b) Receiving, in the server computer, price information for determining a price that a bidder thinks acceptable to pay for the product from each of the plurality of client computers via the network (Fisher: Fig. 2, “The current high bidders are.”);

Art Unit: 3625

- c) Judging, in the server computer, whether a current auction price is equal to or lower than the price that the bidder thinks acceptable to pay, for each bidder (Fisher: column 9, lines 18-35 and Fig. 7);
- d) Determining, in the server computer, a remaining bidder who sent the price information by which it is judged that the current auction price is equal to or lower than the price in step c) (Fisher: column 9, lines 18-35 and Fig. 7);
- e) Judging, in the server computer, that a competitive state occurs when there is more than one remaining bidder in step d) (Fisher: column 9, lines 18-35 and Fig. 7);
- f) If it is judged that a competitive state does not occur in step e), determining, in the server computer, the remaining bidder as a successful bidder (Fisher: column 9, lines 18-35 and Fig. 7); and
- g) If it judged that a competitive state occurs in step e), increasing the auction price by a predetermined value and repeating steps c), d), and e) (Fisher: column 9, lines 18-35 and Fig. 7).

The Examiner notes Fisher preferably includes a "Proxy Bidding" feature that may be applied to any of the auction formats described in Fig. 7. When Proxy Bidding is employed, a bidder places a bid for the maximum amount they are willing to pay. The electronic auction system, however, only displays the amount necessary to win the item up to the amount of the currently high proxy bids of other bidders. Typically, the currently high bids display an amount that is one bidding increment above the second

Art Unit: 3625

highest bid or bids, although a percentage above the second highest bids may be used as well. When a new bidder places a bid that is above a currently displayed high bid, the proxy feature will, in general, cause the currently high bid to move up to an amount higher than the new bid, up to the maximum amount of the currently high bidder's proxy bid. Once a new bidder places a bid in excess of the currently high bidder's proxy bid, the new bid becomes the current high bid and the previous high bid becomes the second highest bid. This feature allows bidders to participate in the electronic auction without revealing to the other bidders the extent to which they are willing to increase their bids, while maintaining control of their maximum bid without closely monitoring the bidding. Participation is engaged in automatically on the bidder's behalf by the inventive system. The feature guarantees proxy bidders the lowest possible price up to a specified maximum without requiring frequent inquiries as to the state of the bidding.

Referring to claim 35. Fisher discloses an auction method in accordance with claim 34, wherein the price information includes a desired price with which a bidder desires to purchase the product and an acceptable price which the bidder accepts to pay in addition to the desired price (Fisher: column 12, line 63 to column 13, line 24).

Referring to claim 36. Fisher discloses an auction method in accordance with claim 34, further comprising the steps of:

- h) Determining, in the server computer, an abandoned bidder who sent the price information by which it is judged that the current auction price is higher than the price in step c) (Fisher: column 9, lines 1-17); and

Art Unit: 3625

- i) Excluding the abandoned bidder (Fisher: column 9, lines 1-17).

Referring to claims 37-39. Claims 37-39 are rejected under the same rationale as set forth above in claims 34-36.

Referring to claims 40-41. Claims 40-41 are rejected under the same rationale as set forth above in claims 34-35.

Referring to claim 42. Fisher discloses an auction method in accordance with claim 41, wherein the order information includes the desired price and the acceptable price (Fisher: column 9, lines 18-35 and Fig. 7).

Referring to claim 43. Fisher discloses an auction method in accordance with claim 40,

wherein the order information further includes a rule defining a condition for participating in the auction (Fisher: column 10, line 63 to column 11, line 20, rule = specified quantity), and

wherein step c) judges whether the current auction price is equal to or lower than the price that the bidder thinks acceptable to pay based on the rule for each bidder (Fisher: column 10, line 63 to column 11, line 20, rule = specified quantity).

Referring to claim 44. Claim 44 is rejected under the same rationale as set forth above in claim 36.

Referring to claims 45-49. Claims 45-49 are rejected under the same rationale as set forth above in claims 40-44.

Art Unit: 3625

Response to Arguments

Applicant's arguments with respect the claim have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew s Gart whose telephone number is 703-305-5355. The examiner can normally be reached on 8:30AM to 5:00PM m-f.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



MSG
Patent Examiner
March 28, 2005